

**REMARKS**

Claims 1 to 4, 6 to 11 and 14 to 16 are canceled without prejudice, and therefore claims 5, 12, 13 and 17 are pending.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the priority claims and for acknowledging receipt of the certified copies of the priority documents.

*As a general matter claims 5, 12, 13 and 17 have been rewritten to better clarify the claimed subject matter and to better conform the form of the claims to that required by the Office.*

In the Office Action, the Title was objected to as not being descriptive. The Title has been rewritten, as suggested. Approval and entry are respectfully requested.

The drawings were objected to because assertedly (to the extent understood) several reference numbers were used to refer to the "same" part. As to Figure 1, and as described at the first three paragraphs of page 5 of the Specification, it is respectfully submitted that Figure 1 only shows a cross-section of the sheet member (such as, for example, a steel sheet) *which is to be used in the claimed method*. As to Figures 3, 4 and 5, the several reference numbers refer to various portions of the wall, etc., of the member during *different* steps of the method, which is why different reference numbers are used in Figures 3, 4 and 5. *The objections are therefore respectfully traversed*. Approval and entry of the present drawings is therefore respectfully requested.

Claim 11 was objected to as not limiting claim 5.

The objection is respectfully traversed, since claim 11 explicitly recites a peripheral wall and a bottom, which are not explicitly recited in claim 5, as presented. Nevertheless, claim 11 is canceled without prejudice to facilitate matters. Withdrawal of the objection is therefore respectfully requested.

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Claims 10, 13 and 17 were rejected under the first paragraph of 35 U.S.C. § 112, as to enablement.

While the rejections may not be agreed with, to facilitate matters, claim 10 has been canceled without prejudice and claims 13 and 17 have been rewritten to better clarify the claimed subject matter. It is noted that the phrase "drawing" may be better understood to correspond to "extrusion forging". If suggested by the Examiner, the claims may be rewritten in this regard (the original application was in Japanese). It is therefore believed that the enablement rejections are obviated. Approval and entry of the rewritten claims is respectfully requested, as is withdrawal of the enablement rejections.

Claim 11 was rejected under the second paragraph of 35 U.S.C. § 112 as to definiteness.

While the rejection may not be agreed with, to facilitate matters, claim 11 has been canceled without prejudice. It is therefore respectfully requested that the rejection be withdrawn.

Claims 1, 2, 5 and 6 were rejected under 35 U.S.C. § 102(b) as anticipated by Saunders, U.S. Patent No. 5,987,951.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Actions to date fail to meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

To the extent that the Office may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App.

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& Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections of the base claims may not be agreed with, to facilitate matters, claims 1, 2, 5 and 6 have been canceled without prejudice. Withdrawal of the anticipation rejections is therefore respectfully requested.

Claims 3, 7, 8, 15 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Saunders and further in view of Kataoka, U.S. Patent No. 6,000,269.

Claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over Saunders and further in view of Maeda, U.S. Patent No. 5,732,587.

Claim 16 was rejected under 35 U.S.C. § 103(a) as unpatentable over Saunders and further in view of the Kataoka and the Maeda references.

Claims 10 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Saunders and further in view of Fukushima, U.S. Patent No. 5,950,480.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must

teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections of the base claims may not be agreed with, to facilitate matters, claims 3, 4, 7, 8, 9, 10, 11, 14, 15 and 16 have been canceled without prejudice and claims 10, 12, 13 and 17 have been rewritten to better clarify the claimed subject matter.

As presented, claim 5 is to a method of forming a case by performing the following: preparing a sheet material, making a thickness of a circumferential portion of the material thinner than a thickness of a center portion of the material, so as to form the circumferential portion as a thin annular portion, which is to be formed as a peripheral wall of the case, so as to provide an intermediate product, and forward drawing the intermediate product so that the center portion of the material is formed as a bottom of the case and the thin annular portion is formed as the peripheral wall of the case to simultaneously form the peripheral wall and the bottom of the case.

It is respectfully submitted that the emphasized features are in no way disclosed or suggested by the applied references, so that claim 5 is allowable, as are its dependent claims 12 and 13.

As presented, claim 17 is to a method of forming a cup-shaped case having an internal boss by performing the following: preparing a sheet material, making a thickness of a circumferential portion of the material thinner than a thickness of a center portion of the material to form a thin annular portion, which is to be formed as a peripheral wall of the case, so as to provide an intermediate product, and simultaneously stamping-forming a concavity in the center portion of the material, and forward drawing an intermediate product obtained by the stamping-forming to form a cup-shaped case having a bottom that is thicker than a peripheral wall so that the center portion of the material is formed as a bottom of the case and the thin annular portion is formed as the peripheral wall of the case.

It is respectfully submitted that the emphasized features are in no way disclosed or suggested by the applied references, so that claim 17 is allowable

Accordingly, claims 10, 12, 13 and 17 are allowable.

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**CONCLUSION**

In view of the above, it is respectfully submitted that all of the presently pending claims 10, 12, 13 and 17 are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully Submitted,

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